

REMARKS

Claims 1-36 are pending. Claims 5 and 17-18 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 18-31 and 34-36 stand rejected under 35 U.S.C. § 101. Claims 1-5, 8-10, 12-23 and 26-36 stand rejected under 35 U.S.C. § 102(e) over Hollingsworth, U.S. Patent No. 6,157,808. Claims 6-7, 11 and 24-25 stand rejected under 35 U.S.C. § 103(a) over Hollingsworth in view of the Examiner's noting that the differences are found only in nonfunctional descriptive material.

By this Amendment, Applicants amend claims 1-36, add new claims 37-41, and traverse the rejections. Reconsideration is respectfully requested.

In paragraphs 2 and 3 of the Office Action, claims 5, 17 and 18 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Applicant has amended claims 5, 17 and 18 to overcome the rejections. Withdrawal of the rejections of claims 5, 17 and 18 on this ground is respectfully requested.

In paragraph 4 of the Office Action, claims 18-31 and 34-36 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter for not being within the technological arts. Applicant respectfully traverses these rejections.

First, Applicant has amended independent claims 18 and 34 to provide that steps therein be performed by at least one processor. Performing a method step by use of a processor clearly falls within the technological arts. Claims 19-31 and 35-36 depend on independent claims 18 and 34 respectively and contain further patentable limitations. Thus, for this reason alone, claims 18-31 and 34-36 are patentable under 35 U.S.C. § 101.

Second, page 4 of the Office Action acknowledges that claims 18-31 and 34-36 meet the useful, concrete and tangible result requirement for patentable subject matter under 35 U.S.C. §101. As far as Applicants are aware, meeting this test alone satisfies the requirement under §101.

As stated in *State Street Bank & Trust Company v. Signature Financial Group, Inc.*, 47 USPQ 2d 1596, 1601-02 (Fed. Cir. 1998), a claim satisfies the requirements of §101 if “the practical application of the abstract idea produces a useful, concrete and tangible result.”

Applicant is unaware of any further requirement that “the claimed invention must be within the technological arts.” This requirement is not specified in the statute, the Code of Federal Regulations or the currently applicable law of the United States. Significantly, this test has never been required by the courts. In applying this test, the Office Action states that the claims are not limited to the technological arts and that “all of the recited steps can be performed in the mind of the user, by use of a pencil and paper, or manually.”

However, steps carried out by humans are patentable if they satisfy the useful, concrete and tangible result test. For example, in *In re Musgrave*, 431 F. 2d 882, 893; 167 USPQ 280, 289 (CCPA 1970), the court expressly stated that a method remains statutory even if all of the steps therein can be carried out in the human mind.

The Supreme Court of the United States has recognized that patentable subject matter has been interpreted to be “anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303 (1980). What may not be patented has been identified by the Supreme Court as “laws of nature, natural phenomena, and abstract ideas.” *Diamond v. Diehr*, 450 U.S. 175, 185 (1981). The present invention is not claiming any of these non-patentable subjects. In addition, there has been no requirement by the courts of the United States that method claims cannot be entirely carried out by hand, nor has the Examiner cited any cases stating such a requirement.

In light of this second reason alone, the subject claims are patentable under § 101.

For both of the reasons stated above, each of which standing alone is sufficient grounds to withdraw the rejections under § 101, claims 18-31 and 34-36 are patentable under 35 U.S.C. § 101. Withdrawal of the rejections of these claims is respectfully requested.

In paragraph 5 of the Office Action, claims 1-5, 8-10, 12-23 and 26-36 are rejected under 35 U.S.C. § 102(e) over Hollingsworth, U.S. Patent No. 6,157,808. Applicant respectfully traverses these rejections.

Nowhere does Hollingsworth show or suggest, as required in independent claim 1, “a source of licensing requirements information, said licensing requirements information including at least information related to obtaining and maintaining respective licenses with a plurality of licensing authorities.” Similar limitations also appear in independent claims 18 and 34.

In rejecting this limitation (specifically with respect to claim 18) the Office Action cites to column 2, lines 43-45 of Hollingsworth. Applicants respectfully disagree that this portion of Hollingsworth teaches anything with respect to obtaining licensing requirements information from a licensing authority, let alone such information from a plurality of licensing authorities.

Hollingsworth at column 2, lines 43-45 merely teaches a qualification module that contains “performance information, compliance information, certification information, and evaluations.” Applicants respectfully submit that none of these types of information teaches or suggests the licensing requirements from a plurality of licensing authorities as required by independent claims 1, 18 and 34. Withdrawal of the rejections of independent claims 1, 18 and 34 as well as their dependent claims is respectfully requested.

On page 6 of the Office Action, claims 6-7, 11, and 24-25 are rejected under 35 U.S.C. § 103 over Hollingsworth in view of the Examiner’s noting that the differences are found only in nonfunctional descriptive material. Although Applicants disagree with the

Examiner's characterization of the limitations of the dependent claims, as explained above with respect to § 102, each independent claim of the present application contains a limitation claiming using information from a plurality of licensing authorities. As a result, a *prima facie* case of obviousness cannot be made for any claim in the present application because neither Hollingsworth nor any citation by the Office Action, alone or in combination, contain each and every limitation claimed. M.P.E.P. § 2143. Accordingly, claims 6-7, 11, and 24-25 are patentable under 35 U.S.C. § 103. Withdrawal of the rejections of these claims on this ground is respectfully requested.

New claims 37-41 correspond to previously examined claims 5, 11, 15, 16 and 20 respectively, written in independent form. Further, new claims 37-41 are patentable over Hollingsworth for the following reasons.

With respect to claim 37 (claim 5), nowhere does Hollingsworth show or suggest, as required by claim 37, a system for managing licensing information where "licensee information further includes information related to licensee appointments by a supplier of a product that may be sold by said at least one licensee." The Office Action did not even address the limitations as contained in claim 5.

With respect to claim 38 (claim 11), nowhere does Hollingsworth show or suggest, as required by claim 38, a system for managing licensing information including "a licensee agency database, said licensee agency database containing licensee agency information, said licensee agency information including information related to at least one licensee agency." Again, the Office Action did not even address the limitations as contained in claim 11.

With respect to claim 39 (claim 15), nowhere does Hollingsworth show or suggest, as required by claim 39, a system for managing licensing information including "a communication interface capable of accessing at least one state entity responsible for

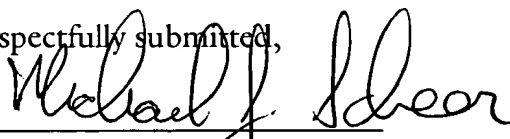
administering licensing information.” Once again, the Office Action did not even address the limitations as contained in claim 15.

With respect to claim 40 (claim 16), nowhere does Hollingsworth show or suggest, as required by claim 40, a system for managing licensing information including “a certified continuing education provider database containing external education provider information, said external education provider information including at least information related to continuing education courses and continuing education requirements satisfied by the continuing education courses.” Hollingsworth is limited to recognizing internal education classes and nowhere teaches or suggests using external education classes.

With respect to claim 41 (claim 20), nowhere does Hollingsworth show or suggest, as required by claim 41, a method for managing licensing information including “providing required forms to said at least one entity.” Once again, the Office Action did not even address the limitations in claim 20.

Applicants have shown that all pending claims are patentable under 35 U.S.C. §§ 101, 102, 103 and 112. Applicants have further shown that new claims 37-41 are patentable over the cited art. In view of the above, each of the pending claims in this application is believed to be in immediate condition for allowance and such action is earnestly solicited.

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Respectfully submitted,

By _____
Michael J. Scheer
Registration No. 34,425
DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP
1177 Avenue of the Americas
41st Floor
New York, New York 10036-2714
(212) 835-1400
Attorneys for Applicant